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EXAMINER JEAN-LOUIS, SAMIRA JM				
ART UNIT		PAPER NUMBER		
1617				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/812,469

Applicant(s)

BAUER ET AL.

Examiner

SAMIRA JEAN-LOUIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/10/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-37 is/are pending in the application.
- 4a) Of the above claim(s) 30, 31 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-29 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 01/10/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is in response to the amendment submitted on 01/10/08. Claims 18-37 are currently pending in the application, with claims 1-17 having being cancelled. Given the response to the election of species/group requirement on August 29, 2007, claims 30-31 and 37 are being withdrawn due to non-elected species. Accordingly, claims 18-29 and 32-36 are being examined on the merits herein.

Receipt of the aforementioned amended claims is acknowledged and has been entered.

Applicant's argument with respect to Schreiber not teaching a water-in-oil emulsion containing glycerol in an amount of 5-50% by weight has been considered but is not found persuasive. Schreiber teaches the use of moisturizers and customary auxiliaries and additives known to one skill in the art as part of his composition (col. 2 lines 22 and col. 14, lines 16-18). Schreiber further exemplified the use of glycerol in his examples 1-20 and 22-27 and further teaches the use of glycine and lactic acid (two additional skin moisturizing agents) in an amount of 0.001-30% (see col. 14, lines 1-2). While Schreiber did not discuss glycine and lactic acid as skin moisturizing agents, a compound's physical property is inseparable from the compound. Thus, Schreiber

necessarily teaches the inclusion of moisturizing agents in his composition in an amount of 0.001-30%. It should further be noted that the recitation of intended use for glycine and lactic acid by Schreiber is irrelevant since such recitation does not further limit claims drawn to a composition.

Applicant's contention that Fujiyama does not teach 5-50% glycerol in his composition is acknowledged but is not found persuasive. Fujiyama was provided to demonstrate that glycerol is well known in the art as an additive/auxiliary agent that can be administered in the range of 1-10%. Examiner further reiterates that regardless if Fujiyama teach the exact percentage, the reference by Schreiber explicitly teaches the inclusion of glycerol in the composition and the addition of glycine and lactic acid (two additional skin moisturizing agents) in an amount of 0.001-30% (see col. 14, lines 1-2). Thus, one of ordinary skill in the art would be motivated to include the aforementioned skin moisturizing agents in the aforementioned range since Schreiber teaches their inclusion in the composition.

For these reasons, the rejection of claims 1-17 under 103 (a) remains proper and is maintained. In view of applicant's amendment, the following modified 103 (a) Final rejection is being made.

IDS

The information disclosure statement filed on January 10, 2008 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the

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relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but only the information in the abstract referred to therein has been considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-28 and 32-33, and 36 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Schreiber et al. (U.S. 6,613,338 B1, previously cited) in view of Pescatore et al. (U.S. 5,753,212).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Schreiber et al. teaches a water-in-oil emulsion (see col. 1, lines 6) which can be formulated as sticks (instant claim 32) comprising a lipid phase made up of an oil component and a wax component, a 30-85% water (instant claims 21-22), a water-in-oil emulsifier, a stabilizer and further customary cosmetic and/or pharmaceutical auxiliaries, active ingredients and/or additives (instant claims 18 and 36; see abstract and col. 3, lines 33-61). This composition entails a water-in-oil emulsion cosmetic stick (see column 1, lines 1-8), which contains the skin-moisturizing agent glycerol at 2% (see examples 1-27, columns 15-23) (instant claims 18-19 and 36) and additional skin moisturizing agents such as glycine and lactic acids in an amount ranging from 0.001-30% (instant claims 18, 20, and 36). Moreover, the work of Schreiber et al. reads upon the majority of the water-in-oil emulsifiers which is embodied by claim 23 and the specific embodiments of claim 24 (see col. 4-6 vs. instant claims 23-24). The work of Schreiber et al. also disclosed the use of polyglyceryl-3-diisostearate, a water-in-oil emulsifier, and the use of a stabilizer in the aforementioned water-in-oil emulsion (see column 5, lines 21-26 vs. instant claim 25; column 6, lines 39-67 and column 7, lines 1-45 vs. instant claims 26-27). Furthermore, the composition of Schreiber et al. may entail pigments and filters (see column 10, lines 55-60 and col. 12, lines 42-43 vs. instant claim 28).

Schreiber et al. does not specifically teach a composition that is spreadable and storage-stable in a temperature range from -10°C to 50°C. Similarly, Schreiber et al. does not teach an emulsion that is solid at room temperature or an emulsion capable of being filled at a temperature of 90°C.

Schreiber et al. does teach that their invention has met the ideal profile of a stick requirement which includes smooth application (i.e. spreadability) and resistance to breaking and temperature without losing oil (instant claim 33; see col. 1, lines 18-23, 42-48, col. 11, lines 31-32 and col. 14, lines 46-50). Moreover, applicant is reminded that a prior art reference may "render obvious" "anticipate" without disclosing a feature of the claimed invention, as long as that missing characteristic is necessarily present, or inherent, in the anticipating reference. Please see *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Other precedents of the court have held that inherent anticipation does not require that a person of ordinary skill in the art at the time would have recognized the inherent disclosure. Please see, e.g., *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1351 (Fed. Circ. 2002); *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1366 (Fed. Cir. 1999) (Where the result is a necessary consequence of what was deliberately intended, it is of no import that the article's authors did not appreciate the results". In the instant case, the unappreciated spreadability and storage stability from 10°C-50°C does not require recognition by

Schreiber et al. Given that both the prior art and the instant application contains the same ingredients, the cosmetic stick of Schreiber et al. would necessarily be spreadable and storage stable at the same temperature range.

It is further noted that In re Best, 195 USPQ 430, and In re Fitzgerald, 205 USPQ 594, discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Pescatore et al. teaches that cosmetic product in stick form are normally produced where the product is introduced in molten state (i.e. liquefied state) and thereafter cooled to produce a final solid stick form (see abstract and col. 1, lines 42-45). Pescatore et al. further teaches that a predetermined quantity of a cosmetic product at its molten temperature is normally introduced through one end and thereafter the cosmetic product is cooled to its non-molten form (i.e. liquid, see col. 1, lines 62-66). Pescatore et al. also teaches that the cosmetic product introduced into the body member of the container (i.e. sleeve) is in a molten form at a temperature in the area of 65°C-85°C (instant claim 36-regarding the emulsion being capable of being package at 10°C-50°C; see col. 3, lines 62-65). Pescatore et al. further teaches that this product is then cooled (i.e. solidified) at a temperature in the area of 40°C (instant claims 18 and

36). Given that applicant did not point out the criticality of the 90°C temperature, Pescatore et al. necessarily reads on claims 18 and 36 since he teaches that the molten temperature is at about 65°C-85°C and solidifies at a temperature lower than 40°C.

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to utilize the composition of Schreiber et al. he teaches a water-in-oil emulsion cosmetic stick containing a lipid phase with oil, wax, a 30-85% aqueous phase, moisturizing agents, and polyglyceryl-3-diisostearate. Given that Schreiber et al. teaches a cosmetic stick of water-in-oil emulsion, and Pescatore et al. teaches that such composition is in a molten form at a temperature are of 65°C-85°C and becomes solid at a temperature of 40°C or lower, one of ordinary skill would have been motivated to utilize the composition of Schreiber et al. in light of the disclosure of Pescatore et al. with the reasonable expectation of providing a water-in-oil emulsion stick that is moisturizing, spreadable, and storage- stable and comparable to applicant's invention.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over are rejected under 35 U.S.C. 103 (a) as being unpatentable over Schreiber et al. (U.S. 6,613,338 B1, previously cited) in view of Pescatore et al. (U.S. 5,753,212) as applied to claims 18-28 and 32-33, and 36 above and in further view of Butuc (U.S. 2002/0055562 A1, previously cited).

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The Schreiber and Pescatore references are as discussed above and incorporated by reference herein. However, Schreiber and Pescatore do not address the addition of an anti-wrinkle substance in the water-in-oil emulsion stick.

Butuc teaches gel sticks (see page 21, paragraph 122) containing ubiquinone (see page 11, paragraph 50) and anti-wrinkle agents (see page 20, paragraph 118) (instant claim 29)). Butuc has been provided to demonstrate that ubiquinone and anti-wrinkle agents can be added to cosmetic stick in order to beautify and alter appearances.

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to add ubiquinone as an anti-wrinkle agent in view of the knowledge of provided by Butuc to the composition of Schreiber et al. since Butuc teaches these substances as beauty aid ingredients. Given that Schreiber teaches a water-in-oil emulsion stick, and Pescatore et al. teaches that such composition is in a molten form at a temperature are of 65°C-85°C and becomes solid at a temperature of 40°C or lower, and Butuc discloses that ubiquinone and anti-wrinkling agents can also be added to cosmetic sticks for enhanced beauty applications, one of ordinary skill would have been motivated to add ubiquinone and additional anti-wrinkling agents to the composition of Schreiber et al. in light of the disclosure of Butuc with the reasonable expectation of providing a water-in-oil emulsion stick that is moisturizing, spreadable and storage-stable.

Claims 34-35 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Schreiber et al. (U.S. 6,613,338 B1, previously cited) in view of Pescatore et al. (U.S. 5,753,212) as applied to claims 18-28 and 32-33, and 36 above and in further view of Fabrisi (U.S. 5, 860, 756, previously cited).

The Schreiber and Pescatore references are as discussed above and incorporated by reference herein. However, Schreiber and Pescatore do not address the water-in-oil emulsion stick in a sleeve-like packaging filled on both sides.

Fabrisi teaches a top-fill/bottom-fill versatile cosmetic carrier for a lipstick container that can be filled either from the top or the bottom (see abstract and col. 2, lines 14-20; instant claim 35). Fabrisi further teaches that such carrier has utility for various cosmetics and that this carrier is positioned within a tubular inner sleeve (instant claim 34 see column 4, lines 8-40 and col. 3, lines 43-48).

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to add the composition of Schreiber et al. in view of Pescatore et al. into the carrier of Fabrisi to arrive at the composition of applicant in a sleeve like packaging since Fabrisi teaches the use of such sleeve like packaging carriers for better versatility and ease of application. Given that Schreiber teaches a water-in-oil emulsion stick and Fabrisi teaches a tubular sleeve carrier for such composition that is top or

bottom filled, one of ordinary skill would have been motivated to add the composition of Schreiber et al. into the carrier of Fabrisi in of his disclosure with the reasonable expectation of providing a water-in-oil emulsion stick that is versatile and easily applicable as is the composition disclosed in applicant's invention.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samira Jean-Louis whose telephone number is 571-270-3503. The examiner can normally be reached on 7:30-6 PM EST M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. J. L. /

Examiner, Art Unit 1617

04/03/08

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617